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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,723	11/24/2003	Lance Shetler	047711-0333	2762
23392	7590	12/17/2004	EXAMINER	
FOLEY & LARDNER 2029 CENTURY PARK EAST SUITE 3500 LOS ANGELES, CA 90067			ELKINS, GARY E	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/720,723	Applicant(s) SHETLER ET AL.	
	Examiner Gary E. Elkins	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040518</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Applicant is advised that should claim 27 be found allowable, claim 28 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 10-13, 15-20, 27 and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 15-21 and 23-26 of prior U.S. Patent No. 6,752,299. This is a double patenting rejection.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 3727

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-9, 14 and 21-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 15, 28, 29, 31 and 36 of U.S. Patent No. 6,752,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements in each of claims 1-9, 14 and 21-26 of the application are found in respective claims 1-11, 15, 28, 29, 31 and 36 of the patent. The difference between the application claims and the respective patent claims lies in the fact that the patent claims include more elements and are thus more specific. The invention in the patent claims are in effect a species of the generic invention of each of the application claims. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since each of the application claims is anticipated by respective of the patent claims, they are not patentably distinct therefrom.

Claim Rejections - 35 USC § 112

6. Claims 4, 5, 22, 23 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3727

In claim 4, line 1, “the ratchet mechanism” lacks antecedent basis in the claim, i.e. the element is only inferentially set forth.

In claim 22, line 3, “an electronic device” appears to be a double inclusion of an element insofar as a medical device was previously defined in line 2.

Each of claims 23 and 25-28 are grammatically unclear. The term “in” is queried.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 6 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima et al. Tajima et al discloses a harness portion 21, a clip portion 22 and a rotatable mechanism 23, 24 which allows rotation of the harness portion relative to the clip portion while maintaining each rotational position. With respect to claim 14, the mechanism also includes a hinge 23 insofar as claimed.

9. Claims 1-9, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Uehara (JP ‘233). Uehara discloses a harness portion formed by a case 27 and portion 6, a clip portion 4, 8 and a mechanism 5, 13, 15 which rotatably connects the harness and clip portion as claimed. With respect to claims 4, 5, 8 and 9, pawl ratchet elements 13 engage ratchet engagement elements 5 as claimed. With respect to claim 14, note is made that the hinge formed between the elements 4 and 5 in Uehara allow the harness portion 27 to rotate upwardly around and to either side of the hinge.

Art Unit: 3727

10. Claims 1-3, 6, 7, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. Phillips et al discloses a harness portion 12, a clip portion 14 and a rotating mechanism or hinge which maintains the position of the harness portion in various rotational positions. With respect to claim 14, note is made that the hinge about which the portions rotate in Phillips et al allow the harness portion to rotate upwardly around and to either side of the hinge.

11. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Chen '282. Chen '282 discloses a harness portion 1, a clip portion 2, 4 and a hinge 13 as claimed.

12. Claims 1, 2, 6, 7, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickey. Dickey discloses a harness portion 16, a clip portion and a rotation mechanism or hinge 54, 56, 39. The rotation mechanism maintains the harness portion 16 in the desired rotational position as claimed.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 22, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Tajima et al, Phillips et al, or Uehara, each in view of either Field et al or Livingston et al. Each of Tajima et al, Phillips et al, and Uehara discloses all structure of the claimed holster except a medical device having medical tubing (cl. 22) or a medical infusion pump (cls. 23 and 25) within the holster. Each of Field et al and Livingston et al teach that it is known to attach an

Art Unit: 3727

infusion pump to a person using belt attachment devices. It would have been obvious to size and shape the holster in any one of Tajima et al, Phillips et al, or Uehara and to place an infusion pump within the holster as taught by either Field et al or Livingston et al to allow the advantages such as rotatability evidenced in any one of Tajima et al, Phillips et al, or Uehara to be used with an infusion pump. The substitution of one well known electronic device for another as the contents to be carried within the holster is considered prima facie obvious.

15. Claims 22, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Tajima et al, Phillips et al, or Uehara, each in view of Heyman. Each of Tajima et al, Phillips et al, and Uehara discloses all structure of the claimed holster except a medical device having medical tubing (cl. 22) or a medical monitor (cls. 24 and 26) within the holster. Heyman teaches that it is known to attach a medical monitor to a person using belt attachment devices. It would have been obvious to size and shape the holster in any one of Tajima et al, Phillips et al, or Uehara and to place a medical monitor within the holster as taught by Heyman to allow the advantages such as rotatability evidenced in any one of Tajima et al, Phillips et al, or Uehara to be used with a medical monitor. The substitution of one well known electronic device for another as the contents to be carried within the holster is considered prima facie obvious.

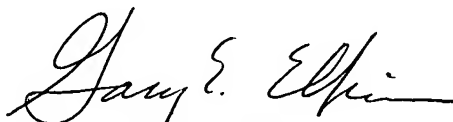
Conclusion

In order to reduce pendency and avoid potential delays, Technology Center 3700 is encouraging FAXing of responses in Office Actions to (703)872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by Applicants who authorize charges to a PTO deposit account. Please identify the Examiner and art unit at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. Also, copies of an office action or other file information may be obtained from the Private PAIR system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions regarding access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Gary Elkins at telephone number (571)272-4537. The Examiner can normally be reached Monday, Wednesday and Thursday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Lee Young can be reached at (571)272-4549.



Gary E. Elkins
Primary Examiner
Art Unit 3727

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10 December 2004